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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Takeshi SHIMIZU et al.

Group Art Unit: 2176

Application No.: 09/974,055

Examiner: C. Huynh

Filed: October 11, 2001

Docket No.: 028918.01

For: HYPERMEDIA DOCUMENT AUTHORIZING

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Technology Center 2100

Director of the U.S. Patent and Trademark Office  
Washington, D.C. 20231

Sir:

In reply to the October 2, 2002 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks. Claims 1-14 are pending in this application.

The Office Action rejects claims 1-12 under 35 USC §103(a) as unpatentable over U.S. Patent 6,029,182 to Nehab et al. This rejection is respectfully traversed.

Claims 1, 6 and 10 recite that the goals outline comprises organization of document information content. The Office Action asserts (1) that, in Nehab et al., Fig. 3A and col. 6, lines 20-38, the tree structure of the homepage site # 21 shows the organization of the homepage content) and (2) that the user interface includes a display device, the controller displaying the goal outline display on the display device and generating the goal outline based on the input that relates to the goals outline display, with reference to Fig. 9B).

Applicants suspect that the Office Action used the previous Office Action as a template and the reference to Fig. 9B regarding the rejection of claim 2 was intended to refer to Fig. 3A because Fig. 3A is now listed as the basis of the goals outline in the rejection of

claim 1. To the extent that the Office Action is relying on Fig. 9B to disclose a goals outline, Applicants respectfully traverse that reliance based on the remarks presented in the Amendment filed June 27, 2002 regarding that issue, those remarks being incorporated by reference herein. However, Applicants believe that the reference to Fig. 9B is inadvertent and will direct the rest of these remarks based on the Office Action's presumed reliance on only Fig. 3A to disclose a goals outline.

Applicants respectfully point out that Fig. 3A, which is a graphical display of a typical Web site 21 with news information contained therein, is not "the goals outline . . . of the document" nor is it a "goals outline" which "comprises organization of document information content . . . of the document" as recited.

Applicants recite a "goals outline." As clearly set forth on page 2 of Applicants' specification, "[T]he goals outline organizes the information content of the document . . ." In other words the goals outline of a document to be authored provides the general organization for the content of the document to be authored, i.e., the information content to be communicated to a reader. Fig. 3A is not the organization of the information content of a document to be authored. Rather, Fig. 3A is merely a graphical presentation of the information content of a homepage which includes the links between the individual items of information in the homepage and at least one item on another web-site, and a homepage on the Internet is not a document to be authored by Nehab.

Moreover, claim 1, for example, recites linking the goals outline to the document presentation outline based on the input and the data to at least partially author the document, wherein the document goals outline comprises organization of document information content and the presentation outline comprises document appearance characteristics. Nehab does not author the Web page represented by Fig. 3A, nor does Nehab disclose or suggest the recited linking feature.

Claim 1 recites a goals outline for a document and a presentation outline for the document. Nehab's Fig. 3 relates to a Web based document whereas the presentation outline of Nehab relates to another document. The Office Action is addressing two different documents. The Office Action asserts that a Web page document is allegedly the claimed goals outline, and asserts that an entirely separate, personal, document is allegedly the claimed presentation outline, whereas the claims are directed to a goals outline and a presentation outline for the same document. This latest interpretation of Nehab simply does not address the claimed invention.

Furthermore, any linking in Nehab is of web-site content and personal document format, and web-site content is not an organization of document information content.

Similar comments apply to claims 6 and 10, which recite that the document goals outline comprises organization of document information content.

The rejection is also traversed based on the lack of proper motivation to one of ordinary skill in the art to modify Nehab to include a controller coupled to a user interface and a memory that links a goals outline comprising organization of document data and a presentation outline for the same document (which is not disclosed in Nehab for the reasons stated above).

Nehab does not need such a controller and the only suggestion for having such a controller is in Applicants' own disclosure. This motivational statement is based on improper hindsight reconstruction of Applicants' claimed invention from Applicants' disclosure.

The first requirement of proper motivation is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the

nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d at 1000, 50 USPQ2d 1614, at 1617 (Fed. Cir. 1999).

Applicants also respectfully point out that the rejection fails to demonstrate a clear and particular teaching to motivate one to modify Nehab. The alleged motivation is just an inference drawn by the Office Action from Nehab and thus is not a clear and particular teaching in Nehab. In fact, the inference in the Office Action clearly did not lead Nehab to make the asserted modification. The alleged motivation is nothing more than speculation and is actually based on Applicants' disclosure rather than Nehab's disclosure.

Moreover, the case law requires that for motivation to be proper, showing that something is feasible is not enough. Just because something may be feasible does not mean that it is desirable or that one of ordinary skill in the art would be motivated to do what is feasible. See Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580 (Fed. Cir. 2000) which points out that motivation to combine references requires a showing not just of feasibility, but also of desirability.

The only desirability of modifying Nehab to arrive at the claimed invention is found in Applicants' disclosure and it is fundamentally improper to use Applicants' disclosure against them.

Moreover, even if Nehab were modified as asserted in the Office Action, the resulting modification would not render the claimed invention obvious for the reasons stated above,

including the fact that the claims recite a goals outline and a presentation outline for the same document, not separate documents.

Additionally, because claims 2-5 depend from claim 1, the Office Action also fails to make out a prima facie case of obviousness of claims 2-5.

With respect to the merits of claim 2, in addition to not showing the features of claim 1 discussed above, Nehab does not display a goals outline which comprises organization of document information content on the display device and does not generate the goals outline based on the input that relates to the goals outline display. Moreover, Fig. 3A of Nehab is not disclosed as being displayed to a user. What is displayed to a user is shown, for example, in Fig 9. The user selects the personal document format and does not need to be presented with what is shown in Fig. 3A.

With respect to the merits of claim 3, in addition to not disclosing the features recited in claims 1 and 2 discussed above, Nehab et al. does not disclose or suggest a controller generating a logical structure of the goals outline, as recited in claim 3. The document prototype is part of the goals outline. Nehab et al. does not disclose any goals outline document prototypes to be instantiated and selected by the input received through the user interface. While Nehab et al. has a profile manager 38, the profile manager maintains document templates that specify how to format a personal newspaper, using predefined document templates, which specifies layout information, font information, style information, colors, etc. These templates are presentation templates, not goals outlines. Accordingly, claim 3 is not rendered obvious by Nehab et al.

With respect to the merits of claims 4 and 5, claim 4 depends from claim 3, claim 5 depends from claim 4, and claim 4 recites that the memory contains a card and linking the instantiated document prototype to the card selected by the input received through the user interface. Because Nehab et al. does not recite the features of claim 3, for the reasons stated

above, Nehab et al. does not anticipate or render obvious the subject matter of claims 4 and 5. Moreover, Nehab et al. has no disclosure of a card or any disclosure of an instantiated document prototype to link with information contained in memory. The assertion in the Office Action that a card is merely where to store data is incorrect. Applicant's disclosure states, on page 5, lines 29-31 that the cards in the card database 106 are information elements (called points) on which the document being authored are based. That is, the cards contain the actual hypermedia information such as video, sound or text that make up the document. The contents of the points may be appropriated from either external sources or created from scratch by the author. Accordingly, claims 4 and 5 are neither anticipated nor rendered obvious by Nehab et al.

With respect to claim 6, Nehab et al. fails to anticipate or render obvious claim 6, because claim 6 recites method steps corresponding to the apparatus features of claim 1, and claim 1 is neither anticipated nor rendered obvious by Nehab et al for the reasons stated above. Moreover, linking the alleged goals outline of Fig. 3A to the presentation outline of the personal outline would not be obvious because the alleged goals outline of Fig. 3A is irrelevant to the presentation outline in the personalized document. Nehab doesn't need or want the alleged goals outline shown in Fig. 3A in the disclosed personalized document, which is why Nehab et al. lets the user create a personalized outline. Under those circumstances, there would be no desirability to link the two.

Moreover, the assertion on page 6 of the Office Action, that a personalized document cannot be created without the claimed linking, lack basis in reality because Nehab fails to teach such a linking. Since Nehab's device works without such a linking, then the statement that a personalized document cannot be made without such a linking is simply incorrect.

With respect to claims 7, 8 and 9, which recite method steps corresponding to the apparatus features recited in claims 2, 3 and 5, Nehab et al. fails to either anticipate or render

obvious claims 7, 8 and 9 for the same reasons that Nehab et al. fails to anticipate or render obvious corresponding claims 2, 3 and 5 as outlined above.

With respect to claim 10, which recites a method similar to method claim 9, Nehab et al. fails to anticipate or render obvious claim 10 for the essentially the same reasons that Nehab et al. fail to anticipate or render obvious claim 9, which also recites generating a card, a feature also not disclosed or suggested by Nehab, and for the reasons outlined above regarding claim 6, from which claim 9 depends, as outlined above.

For at least the reasons set forth above, Applicant respectfully submits that Nehab et al. fails to teach, disclose or suggest all of the features recited in claims 1-12. Thus, Nehab et al. fails to render obvious the subject matter of claims 1-12 under §103(a). Withdrawal of the rejection of claims 1-12 under 35 U.S.C. §103(a) as unpatentable over Nehab et al. is respectfully solicited.

The Office Action rejects claims 13 and 14 under 35 USC §103(a) as unpatentable over U.S. Patent 5,347,628 to Brewer et al. This rejection is respectfully traversed.

The Office Action admits that Brewer does not explicitly disclose linking a goals outline comprising organization of document information content to a presentation outline based on the input and the data.

To overcome this admitted shortcoming, the Office Action alleges that Brewer suggests a goal outline, which is asserted to be the organization of the content of the office (which includes a desk, a cabinet and a trash can, wherein the cabinet contains drawers and the desk includes drawers containing files and a desktop, a calendar and an in/out basket. The Office Action also alleges that Brewer also discloses a presentation outline, which is asserted to be the presentation of the office with the positions of the desk, the cabinet and the trash can.

The linking of the organization of the office and the presentation of the office based on the input and the data is allegedly shown by the fact that the user can put the cursor on the drawer to pull the drawer open until the files the user is interested in appear in the window.

The Office Action admits that storing of data in memory is not shown but alleges that this would be obvious because "conventionally, the data when created should be stored in a memory for later use."

Regarding claim 14, the Office Action alleges that Brewer discloses a meta-level display of a kitchen image, an office image and a studio image.

This rejection completely fails to take into consideration the fact that claims 13 and 14 recite a method of authoring a document. Brewer et al. never discloses, suggests or contemplates authoring a document. This rejection completely fails to address this positively recited feature of claims 13 and 14 and, accordingly, fails to make out a prima facie case of obviousness of the claimed invention.

Furthermore, claims 13 and 14 positively recite "linking a goals outline comprising organization of document information" in the body of the claims, the word document referring back to the "authoring of a document" in the preamble of claim 13 and "document authoring method" of claim 14. Brewer et al. has nothing to do with document authoring and the rejection completely omits consideration of this positively recited feature in both claims.

The only disclosure of a goals outline for authoring a document and a presentation outline for authoring a document is in Applicant's disclosure.

The Office Action is engaging in wholly impermissible hindsight reconstruction of Brewer et al. based solely on Applicant's disclosure.

As the Court stated in In re GPAC Inc., 35 USPQ2d 116 (Fed. Cir. 1995), "[W]e believe that this statement by the Board in support of its rejection of claim 2 is conclusory

and lacks the factual basis required to validate a claim rejection under section 103. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) ("A rejection based on section 103 must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . [The Board] may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis."), cert. denied, 389 U.S. 1057 (1968).

Brewer et al. merely discloses a graphical user interface for accessing electronic data stored in a computer system. There is absolutely no disclosure of a method of authoring a document, or of a goals outline as recited or of a presentation outline as recited, or of linking a goals outline and a presentation outline as recited. The only basis for that disclosure is Applicant's disclosure. This rejection is a classic example of improper hindsight reconstruction of Applicant's invention based solely on Applicant's disclosure.

Also, the basis for modifying Brewer et al. is not a clear and definite teaching, as required by the case law cited above. The alleged basis of the motivation to modify Brewer et al. is that "the logical structure of the office image suggests the goal outline for creating such an image file and the layout of the office as seen in the figures suggests a presentation outline for an image file." This is not a clear and definite teaching. Rather it is perhaps the farthest stretch of imagination Applicants can conceive. It certainly was not apparent to Brewer et al. In fact, it only becomes apparent to one of ordinary skill in the art after reading Applicants' disclosure.

For at least the reasons outlined above, Applicant respectfully submits that Brewer et al. fails to teach, disclose or suggest all of the features of claims 13 and 14, and no proper motivation has been shown to radically modify Brewer et al. to provide the claimed invention totally missing from the Brewer et al. disclosure which is recited in claims 13 and 14. Thus, Brewer et al. fails to render obvious the subject matter of claims 13 and 14 under

35 U.S.C. §103(a). Withdrawal of the rejection of claim 13 under 35 U.S.C. §103(a) as unpatentable over Brewer et al. is respectfully solicited.

Accordingly, Applicants respectfully request allowance of claims 1-14.

Should the Examiner believe that anything further is needed to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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